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PATENT APPLICATION

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

ATTORNEY DOCKET NO. 200312102-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Radha Sen et al.

Confirmation No.: 9177

Application No.: 10/789,963

Examiner: YOON, Tae H.

Filing Date: February 27, 2004

Group Art Unit: 1796

Title: A System and Method for Forming a Heat Fusible Microporous Ink Receptive Coating

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 29, 2008.

☒ The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).

☐ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$460

☐ 3rd Month
\$1050

☐ 4th Month
\$1640

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 510 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Date of facsimile: June 25, 2008

Typed Name: Carla Jones

Signature: Carla Jones

Rev 10/07(AplBrief)

Respectfully submitted,

Radha Sen et al.

By Steven L. Nichols

Steven L. Nichols

Attorney/Agent for Applicant(s)

Reg No. : 40,326

Date : June 25, 2008

Telephone : 801-572-8088

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By: Steven L. Nichols

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Attorney/Agent for Applicant(s)

Reg No.: 40,326

Date: June 25, 2008

Telephone: 801-572-8066

Rev 10/07 (Ap/Bnet)

JUN 25 2008

Application No.: 10/789,963

Attorney Docket No.: 200312102-1

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents via the USPTO central facsimile number, (571) 273-8300.

on June 25, 2008
Date


Signature

Carla L. Jones

Typed or printed name of person signing Certificate

Transmitted, herewith, are the following documents:

1. Transmittal Letter for Response/Amendment with Duplicate Copy (2 pages)
2. Certificate of Transmission (1 page)
3. Appeal Brief (32 pages)

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In the Patent Application of

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For: A System and a Method for Forming
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Receptive Coating

Group Art Unit: 1796

Examiner: YOON, Tae H.

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APPEAL BRIEF

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Commissioner for Patents
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Sir:

This is an Appeal Brief under Rule 41.37 appealing the decision of the Primary Examiner dated March 6, 2008 (the "final Office Action"). Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately.

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I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

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II. Related Appeals and Interferences

There are no appeals or interferences related to the present application of which the Appellant is aware.

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Claims 26-45 and 59-70 were withdrawn from consideration under a previous Restriction Requirement and cancelled without prejudice or disclaimer. Claims 1-25, 46, 47, 50, 54 and 73-79 were also cancelled previously without prejudice or disclaimer.

Thus, claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 are currently pending in the application and stand finally rejected. Accordingly, Appellant appeals from the final rejection of claims 48, 49, 51-53, 55-58, 71, 72 and 80-90, which claims are presented in the Appendix.

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IV. Status of Amendments

No amendments have been filed subsequent to the final Office Action of March 6, 2008, from which Appellant takes this appeal.

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V. Summary of Claimed Subject Matter

Appellants' sole independent claim recites the following:

48. A print medium having a microporous coating comprising:
- a substrate (112) which serves as a base of said print medium (*Appellant's specification, paragraph 0018*);
- a first microporous layer (114) comprising a first binder deposited as a liquid on said substrate (*Appellant's specification, Fig. 1 and paragraphs 0018 and 21*); and
- a fusible latex layer (150) deposited over said first microporous layer (114) (*Appellant's specification, Fig. 1 and paragraph 0021*), wherein said fusible latex layer (150) is microporous and includes particles comprising a hard core material and a soft shell material (*Appellant's specification, paragraph 0021*);
- wherein said latex (150) exhibits self-adhesive properties at a room temperature such that said latex layer (150) remains in place on said first microporous layer (114) without requiring a second binder and without being fused (*Appellant's specification, paragraphs 0004 and 0026*).

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VI. Grounds of Rejection to be Reviewed on Appeal

The final Office Action raised the following grounds of rejection.

- (1) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
- (2) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.
- (3) Claims 48, 49, 51-53, 55, 57, 58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 102(e) as anticipated by of U.S. Patent No. 7,086,732 to Kasperchik et al. ("Kasperchik").
- (4) Claims 48, 49, 51-53, 55, 57, 58, 71, 72, 80 and 86-89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kasperchik, taken alone.

According, Appellant hereby requests review of each of these grounds of rejection in the present appeal.

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(1) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 comply with the written description requirement of 35 U.S.C. § 112, first paragraph:

According to the final Office Action, the claims are not supported by a written description in the specification as originally filed "since newly recited 'deposited as a liquid on [said] substrate' does not have support in [the] originally filed specification. Appellant points to PP 0021, but the examiner does not see any support for the amendment" to the claims. (final Office Action, p. 2). Appellant respectfully disagrees.

As an initial matter, Appellant would like to point out that a "written description" in the specification supporting a particular claim need *not* be a verbatim recitation of the claim language. Rather, as explained in MPEP § 2163.02, the necessary written description can be provided "using such descriptive means as words, structures, figures, diagrams, and formulas." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

In the present application, claim 48 recites:

A print medium having a microporous coating comprising:
a substrate which serves as a base of said print medium;
a first microporous layer comprising a first binder *deposited as a liquid on said substrate*; and
a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;
wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.

(Emphasis added).

The subject matter at issue in this rejection is highlighted in claim 48 above. This subject matter is supported in Appellant's originally filed application as follows.

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Firstly, Fig. 1 clearly shows the microporous layer (114) being deposited as a liquid on a substrate (112). This alone is adequate written description supporting claim 48.

Additionally, Appellant's specification, as pointed out to the Examiner previously, states the following.

[0021] The ink receptive medium (110) illustrated in Figure 1 is configured to receive a hard core/soft shell latex coating and a recording agent. As shown in Figure 1, the ink receptive medium (110) may include, but is in no way limited to a photo or film base (112) having a microporous substrate (114) disposed thereon. According to one exemplary embodiment, the photo or film base (112) may include any photo base or paper base material. Additionally, according to one exemplary embodiment, the present hard core/soft shell latex coating may be coated on a previously coated latex lattice. As shown in Figure 1, a microporous substrate (114) is disposed on the photo or film base (112) immediately preceding the deposition of the hard core/soft shell latex (150), according to a wet on wet configuration. The microporous substrate (114) may be any material configured to receive a recording agent including, but in no way limited to, a microporous inorganic composition such as fumed silica, colloidal silica, fumed aluminum, or colloidal aluminum; calcium carbonate; polymeric membrane; a plastic pigment; or a previously coated latex lattice.
(Appellant's specification, paragraph 0021) (emphasis added).

Thus, paragraph 0021 clearly states that the microporous substrate and latex are deposited sequentially "according to a wet on wet configuration," i.e., both are deposited in wet, liquid form. One of ordinary skill in this art would clearly understand that a wet on wet deposition, which is a term of art, refers to sequential deposition in liquid form. Consequently, claim 21 also gives the necessary written description in the original specification for the recitation in claim 48 of "a first microporous layer comprising a first binder *deposited as a liquid on said substrate.*" (Emphasis added).

Therefore, the rejection of Appellant's claims under 35 U.S.C. § 112, first paragraph, should not be sustained.

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(2) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 comply with 35 U.S.C. § 112, second paragraph:

The final Office Action mentions a number of reasons for objecting to the claims under § 112, second paragraph. None of these reasons have any merit and some do not even properly allege an instance of indefiniteness under § 112.

(1) The final Office Action argues that “[i]t is unclear whether said deposited liquid stays as a liquid or not on said substrate, and thus claims are indefinite.” (final Office Action, p. 3). It is entirely unclear how this creates any indefiniteness.

As noted above, claim 48 recites “a first microporous layer comprising a first binder deposited as a liquid on said substrate.” Thus, if the first microporous layer is deposited as a liquid, it reads on that portion of claim 48. Whether the layer then stays indefinitely in liquid form is not addressed by, or at issue, with respect to claim 48. Therefore, this particular objection raised by the Examiner is entirely without merit and is *not* an instance of indefiniteness. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

(2) The final Office Action next argues that “[t]he recited preamble, ‘The microporous coating of ---’, in claims 49, 50-53, 55-58, 71, 72 and 80-90 lack a proper antecedent basis in claim 48 wherein ‘A print medium’ is claimed now.” (final Office Action, p. 3). In response, Appellant notes that the Examiner has failed to accurately and completely quote the preamble of claim 48. Claim 48 recites: “A print medium having a *microporous coating* comprising” (Emphasis added). Thus, claim 48 clearly provides antecedent basis for the dependent claims which specify further details of the “microporous coating” recited in claim 48. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

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(3) The final Office Action next argues that “[c]laims 81-84 are confusing and indefinite since they recited polymers (such as polystyrene) for a core material and monomers (such as n-ethylhexylacrylate) for a shell material. Consistency is needed.” (final Office Action, p. 3). This position is unreasonable on its face. Appellant is unaware of any rule that prohibits reciting different types of materials for different components of a composition. Moreover, Appellant fails to see how the claims are in any way inconsistent. Thus, the basis for the Examiner’s rejection here is entirely unclear. However, there clearly is no indefiniteness with respect to the rejected claims. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

(4) Finally, the final Office Action argues that the “recited ‘said shell material comprises a coalescing agent’ in claim 90 is confusing and indefinite since said coalescing agent is a solvent as taught by Kasperchik ... and a solvent cannot form a shell.” (final Office Action, p. 3). Again, this position is unreasonable and entirely without merit.

Appellant does not believe that the cited prior art to Kasperchik requires that a coalescing agent must be a solvent. However, whatever the prior art may say on this subject is largely irrelevant as Appellant has the right to define “coalescing agent” for purposes of the present application and claims. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 888-89, 221 U.S.P.Q. 1025 (Fed. Cir. 1984). Appellant’s specification defines a coalescing agent as an agent that is able to “effectively lower the Tg of the shell for soft shells having a higher than process temperature Tg.” (Appellant’s specification, paragraph 0041). Appellant’s specification then gives specific examples of the claimed coalescing agent. (*Id.*).

This definition for Appellant’s specification informs the recitation of a “coalescing agent” in the claims. Therefore, the allegation of indefiniteness with respect to claim 90 is

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entirely without merit. Consequently, this portion of the rejection under 35 U.S.C. § 112, second paragraph, should not be sustained.

(3) Claims 48, 49, 51-53, 55, 57, 58, 71, 72 and 80-90 are not anticipated by Kasperchik:

Claim 48:

In the present application, claim 48 recites:

A print medium having a microporous coating comprising:
a substrate which serves as a base of said print medium;
a first microporous layer comprising a first binder deposited as a liquid on said substrate; and
a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;
wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.
(Emphasis added).

In contrast to claim 48, the final Office Action does not indicate how or where Kasperchik teaches the claimed "first microporous layer comprising a first binder deposited as a liquid on said substrate." It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation. For at least this reason, the rejection of claim 48 and its dependent claims should not be sustained.

Additionally, Kasperchik does not appear to anticipate the claimed fusible latex layer "wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused." The final Office Action equates the claimed fusible latex layer with a "color-receiving layer 8" taught by Kaspercik. (final Office Action, p. 4.).

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However, in direct contrast to independent claim 48, Kasperchik teaches that the color-receiving layer may include a binder. According to Kasperchik,

The colorant-receiving layer 8 may also include a small amount of polymer binder to bind the core-shell polymer particles 10 into a layer. The polymer binder in the colorant-receiving layer 8 may be one of the polymer binder materials described above for use in the vehicle sink layer 6. For instance, the polymer binder may be a water-soluble or water-dispersible polymer such as gelatin, polyvinyl pyrrolidone, a water-soluble cellulose derivative, polyvinyl alcohol or its derivatives, polyacrylamide, polyacrylic acid, or a water-soluble acrylic acid co-polymer. Preferably, the polymer binder of the colorant-receiving layer 8 is polyvinyl alcohol or a water-soluble or water-dispersible derivative thereof. The amount of polymer binder present in the colorant-receiving layer 8 may be sufficient to bind the core-shell polymer particles together without blocking the pores between the core-shell polymer particles 10. (Kasperchik, col. 6, lines 49-64).

Thus, Kasperchik does not appear to anticipate the claimed subject matter in which "said

latex exhibits self-adhesive properties at a room temperature such that said latex layer